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PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

LEE, Y YOUNG

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/059,145
Filing Date: January 31, 2002
Appellant(s): SUZUKI ET AL.

Robert Perez
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/22/05.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 54-58, 61-65, and 68-70 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,436,655 HIYAMA ET AL 7-1995

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 54, 55, 57, 58, 61, 63-65, and 68-70 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiyama et al.

Hiyama et al, in Figures 4, 5, 13, 18, 19, 21, 25, 37, 42, 64, 66, and 76, discloses the same TV observation system for an endoscope as specified in claims 54, 55, 57, 58, 61, 63-65, and 68-70 of the present invention, comprising an endoscope 202; a TV camera; a light source 255; an optical element 224 that compounds light emitted from the plurality of LEDs (e.g. 255 and 423); a control mechanism 430 that controls electric currents applied to the plurality of LEDs, so that amounts of light emission of the LEDs are set in a desired ratio, wherein the endoscope 202 has an insertion part 207 having a thin and long shape, a holding part 211 continuously extending from a proximal end of the insertion part 207, an eyepiece section 235 formed on the holding part 211, a light guide 217 that introduces illumination to a distal end 227 of the insertion part 207, a light source connecting section (218, 219) formed on the holding part 211 to achieve removable connection of the light source 255, wherein the TV camera has an image pickup element 237 and the TV camera is connected to the eyepiece section 235 of the endoscope 202, wherein the light source comprises a plurality of LEDs (255, 423), the light source is removably connected to the light source connecting section 218, and the light source supplies illumination light to the light guide 217 of the endoscope 202; and

wherein the light source is configured to sequentially emit a light of at least three colors (R, G, B), and comprises a LED that emits red light R, a LED that emits green light G, and a LED that emits blue light B.

Claims 56 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiyama et al (5,436,655).

Although Hiyama et al discloses supplying an electric current to the light source 255, it is noted Hiyama et al differs from the present invention in that it fails to particularly disclose a battery as specified in claims 56 and 62. However, Examiner takes Official Notice that such common power supply is notoriously well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to exploit the well known alternative sources of power supply such as the common battery for the TV observation system of Hiyama et al in order to provide a portable endoscope that is more compact in design.

(11) Response to Argument

Appellant asserts on pages 8 and 12 of the Brief for claim 54 (and similar arguments for claims 61 and 68) that Hiyama et al fails to disclose an eyepiece unit. However, it is submitted the description for such unit can only be found on page 5, line 3 (as noted on p. 4 of the Brief) and page 9, line 17 of the Specification. In these two lines, appellant defines the eyepiece unit as merely the connection between element 1 and element 4 (in Fig. 1, or element 10 in Fig. 2). No further details are given pertaining to the function or structure of the eyepiece unit. Therefore, it is submitted that the

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connection between the endoscope body (i.e. left hand portion in the various Figures 4, 5, 13, 18, 19, 21, 25, 37, 42, 64, 66, and 76) and the signal processor (i.e. right hand portion of the various Figures) of Hiyama et al meets the definition of an eyepiece unit in its broadest reasonable sense, consistent with appellant's specification.

Appellant asserts on pages 8 and 9 of the Brief that Hiyama et al fails to disclose "a holding part continuously extending from a proximal end of the insertion part."

However, Figures 1, 2, and 11 of appellant's drawings merely illustrate an endoscope body 1 extending from an insertion part (left half of element 1) to a holding part (right half of element 1). No other description can be found in the specification. Therefore, it is submitted that the endoscope body (1, 202, 272, 302, etc. in the various Figures 4, 5, 13, 18, 19, 21, 25, 37, 42, 64, 66, and 76) of Hiyama et al meets the definition of a holding part (e.g. horizontal portion) continuously extending from a proximal end of the insertion part (e.g. vertical portion) in its broadest reasonable sense, consistent with appellant's specification.

Appellant asserts on pages 9 and 12 of the Brief that Hiyama et al fails to disclose a TV camera. However, it was stated in the previous office actions that although Hiyama et al discloses various optical system elements such as a CCD 232, it does not illustrate any detailed connections of a TV camera. Nonetheless, Hiyama et al at least implicitly, if not explicitly, discloses from column 74, line 67 to column 75, line 5 that the endoscope illustrated in Figures 4, 5, 13, 18, 19, 21, 25, 37, 42, 64, 66, and 76 can be arranged in which a TV camera building therein is mounted on an optical endoscope. With such an arrangement, one of ordinary skill in the art would have had

no difficulty in realizing that an optical endoscope would inherently pick up all images optically.

Appellant asserts on page 10 of the Brief that Hiyama et al fails to disclose the light source is removably connected to the light source connection section. However, column 20, lines 58-62 of Hiyama et al explicitly disclose the concept of such connections wherein the light source unit 205 is detachably connected to the endoscope 202.

Appellant contradictorily asserts on page 11 of the Brief that Hiyama et al discloses a single LED. Yet concedes on the very next paragraph that element 423 of Hiyama et al corresponds to a group of LEDs. It is submitted that one of ordinary skill in the art would have had no difficulty in recognizing that a group of LEDs is more than a single LED, and thus is a plurality of LEDs.

Appellant asserts on page 12 of the Brief that "it is improper to pick and choose elements from different embodiments" of Hiyama et al by substituting a plurality of LEDs for a single LED. However, the issue here is merely a duplication of parts for a multiple effect. That is, unless by using a plurality of LEDs produces novel and/or unexpected results, such duplication in parts is merely considered as well known design options that is obvious to one of ordinary skill in the art because adding an extra LED provides no significant functional or patentable differences for a light source.

Appellant asserts on pages 14 and 15 of the Brief that Hiyama et al fails to disclose any control mechanism that controls electric currents to the light source. However, Figure 42 (col. 43, lines 46-53) and Figure 64 (col. 59, lines 10-20 and 50-57)

of Hiyama et al, for example, discloses the concept of such necessary control mechanism in order to have an operational endoscope.

Appellant asserts on page 15 of the Brief that Hiyama et al fails to disclose at least three colors emitted from the light source. However, Figures 41, 48, 51, and column 49, lines 41-54 of Hiyama et al discloses the concept of such common configuration wherein the light source sequentially emit a light of at least three colors (R, G, B).

Appellant repeatedly asserts the same arguments on pages 16-23 of the Brief. It is submitted that the above citations from Hiyama et al fully addressed all similar arguments presented in corresponding independent claims and their dependent claims.

Finally, appellant asserts on pages 23 and 24 of the Brief that Hiyama et al fails to disclose a battery. However, it is submitted that Examiner took Official Notice that such common power supply is notoriously well known in the art (see Section 8 of the Office Action dated 11/4/03). In the subsequent response, appellant conceded to Examiner's Official Notice. Therefore, it is believed that no further response is necessary at this time. Nevertheless, US patents 4,930,861 (Okabe et al) and 4,918,521 (Yabe et al) are cited herein to support the well known feature wherein a battery supplies the electric current to the light source within an endoscope.

(12) Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




Y. Lee
Primary Examiner
Art Unit 2613

yl
April 4, 2005

Conferees
Chris Kelley--SPE A.U. 2613
Chris Grant--SPE A.U. 2611

PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102



CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600



CHRIS GRANT
PRIMARY EXAMINER